



Attorney Docket: A39-972-011

March 26, 2003

#25
4-4-03
B.H. Hall
1 of 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Patent Application of

ROBERT H. SHELTON

Serial No. 09/025,279

Filed: February 17, 1997

For: STANDING ORDER DATABASE
SEARCH SYSTEM AND METHOD
FOR INTRANET AND INTERNET
APPLICATION

GROUP ART UNIT: 2172

EXAMINER: Jean B. FLEURANTIN

BEFORE THE BOARD OF
PATENT APPEALS AND
INTERFERENCES

REPLY BRIEF TO EXAMINER'S ANSWER

HONORABLE COMMISSIONER OF PATENTS
AND TRADEMARKS
Washington, D. C. 20231

Sir:

Pursuant to the provisions of 37 CFR 1.193, Appellant
responds to the Examiner's Answer as follows:

General Overview: The Examiner's Answer includes a number of mis-
statements, inaccuracies, oversights and non-sequiturs, that as
will be observed from the text itself and from the following
discussion, ultimately result in unsupportable and erroneous
conclusions.

Since additional case law is relied upon in this Reply Brief, a supplement to Appendix B of Appellant's Appeal Briefs is submitted herewith to add references to the additionally cited authorities. In addition, the Examiner has repeatedly rejected the claims based upon knowledge of a person ordinary skill in the art without first establishing that such knowledge exists in the art. Further, the Examiner does not state the basis for contending that one skilled in the art would be inclined to combine the two references relied upon without improper hindsight reasoning. And also, the Examiner fails to address in any way the extensive evidence provided by Appellant including substantial evidence of long-felt need answered by Appellant's claimed invention which overcomes obviousness even if one accepted *arguendo* the rationale advanced by the Examiner. Failing not just one but in fact ALL of the foregoing, Appellant contends (a) the Examiner's conclusions are erroneous, (b) these conclusions should be reversed on appeal, and (c) Appellant's application should be remanded to the Examiner for allowance.

All of the foregoing can be readily observed from the prosecution history to date. To facilitate consideration by the honorable Board of Appeals (hereinafter the "Board"), comments are now set forth in the same order as the material appears in the Examiner's Answer.

1... Page 2, item (7):... The Examiner's Answer contains the

representation "Appellant's brief includes a statement that the claims stand and fall together." However, this is not true. To the contrary, Page 6 of Appellant's original brief includes the statement under the heading "Grouping of Claims": "The claims on appeal are separately patentable and do not stand and fall together; and the reasons for the separate patentability are as follows." Similarly, on page 8 of Appellant's Supplemental Brief, there appears the statement: "The claims on appeal are separately patentable and do not stand and fall together; and the reasons for the separate patentability are as follows."
(Underscoring added).

2. On page 3, item (9), the identification of the inventor of the cited reference appears incorrect. The indicated patent shows the patentee's name to be Evans, not Evan.

CLAIM REJECTIONS - 35 U.S.C. 103

3. On Page 3, commenting on the basis for rejecting claims 1-42 as unpatentable over Evans (U.S. Patent 5,924,074), the Examiner characterizes Evans as teaching "a medical data base supervisory control system." This statement mis-characterizes both the nature and scope of Evans, which it will be observed does not even once use the terms "supervisory" or "control" anywhere in the specification, drawings or claims of the patent. In point of fact, as distinguished from Appellant's invention that expressly advances the art for both the supervision and

control of medical records, Evans is simply a system for storing and retrieving electronic medical records, and incorporates by reference the "components that support data definition, data access, security, programming language interface and data administration" of database management systems known in the art as of the time of said invention. (See Evans, Col. 13, Line 59 to Col. 14, Line 7). On Page 3, Section 1(b), it is not understood why the words "including interconnected computers" are underscored.

4 a. Page 4, item (c), line 2: The parenthetical statement is made "(thus, authorized health care providers can access a record while other providers use the same record, which is readable as identifying medical data for each of said patients with condition (sic) required for accessing said medical data) (see col 2, lines 53-64)." Appellant's comment: This is a clear non-sequitur. In point of fact, it is illogical to either conclude or infer from a piece of prior art that shows permitting concurrent access by multiple providers (i.e., an enabling condition) that the prior art teaches identifying conditions required for accessing data (i.e., a limiting condition). Appellant avers that such a conclusion is clearly erroneous.

4 b. The Examiner proceeds to admit at line 5 of item (c): "But, Evans does not explicitly indicate data processing means responsive to a request for patient medical data for comparing

said request with said conditions required for access to said data and, when said request fails to comply with said conditions, for denying access to said data." Nevertheless, and without explaining how it does so, the Examiner states: "However, Evans implicitly indicates the point of care system issues a request for patient data the patient locator receives the request from the point of care system and attempts to find the patient id for the record having the requested patient data as determined, if no patient id is found the patient locator reports an error at this point the patient data repository may recover from the error by either restarting the process or by ending the process; which is readable as data processing means responsive to a request for patient medical data for comparing said request with said conditions required for access to said data and, when said request fails to comply with said conditions, for denying access to said data . . ." (Underscoring of "implicitly" added). (As discussed in greater detail below, "implicitly" is synonymous with "inherently.") The Examiner then states that "it would have been obvious to a person of ordinary skill in the art to modify the teachings of Evans with the step of data processing means responsive to a request for patient medical data for comparing said request with said conditions required for access of said data and, when said request fails to comply with said conditions, for denying access to said data." (Emphasis added). Continuing,

"This modification" "would allow the teachings of Evans to improve the accuracy and reliability of the standing order database search system and method for internet (sic) (intranet?) and internet application, and provide instant access to a patient's electronic medical record by authorized health care providers from any geographical location" (emphasis added). Appellant's observation: The Examiner's admission that the elements taught by Appellant (i) represent a modification, and (ii) result in an improvement over the system taught by Evans would appear to be an argument in support of (rather than in derogation of) patentability, for if Appellant's modification provides an improvement (a long-felt need in the art, as mentioned below and as cited in Appendix C to the Supplemental Brief), this is a well-recognized factor supporting non-obviousness. Notwithstanding, not only does the Examiner's Answer fail to properly account for the fact of the modification and improvement he expressly acknowledges are present over the prior art, Appellant finds no reference whatsoever in the Examiner's Answer to Appellant's extensive arguments relating to long-felt need which oversight is commented on in greater detail below.

4 c. The above-quoted Examiner's conclusion that "it would have been obvious to a person of ordinary skill in the art to modify the teachings of Evans" as defined by Appellant's claim is

merely stated without support. The Examiner does not provide any evidence (nor could he) that such a modification was well known in the art, much less cite any prior art reference that expressly suggests so doing. According to Appellant's understanding (and as set forth in his cited authorities) there must be shown some basis for such conclusion. Having failed to provide any, the Examiner's conclusion is unsupportable and cannot be countenanced as forming the basis for rejecting Appellant's claims.

5. Turning to page 5 of the Examiner's Answer, there are several non-sequiturs. In the first paragraph, the Examiner writes parenthetically: "(thus, the [Evans] system provides several levels of security for access to patient data, which is readable as the identity of the requesting party)". However Evans does not teach or suggest that several levels of security is to be read as authenticating the identity of a party, nor is there any indication given that such a proposed reading is the ordinary and customary meaning of the term in the field. However, even if such reference to a tiered password system in Evans were considered to teach or suggest authenticating the identity of a party as defined by Appellant's claims, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

6. In the second paragraph on page 5 of the Examiner's Answer, the statement is made that "the healthcare provider can

track referrals by entering the identity of persons who referred this patient to their care, which is readable as tentatively identifying records fulfilling the criteria specified in said request for medical (sic)." Once again, there is no basis in either the teachings of Evans or the ordinary and customary meanings given to terms in the field to conclude or infer that tracking referrals by entering the identity of persons referring a patient to their care should be read as tentatively identifying records fulfilling criteria specified in a request for medical (data). These are different concepts and the Examiner provides no explanation as to why one would be inclined to view them as being one and the same, nor would this be a proper reading either of Evans or Appellant's invention. However, even if such reference in Evans to a tracking of referrals by entering the identity of persons who referred them were considered to teach or suggest tentatively identifying records fulfilling criteria specified in a request for medical data as defined by Appellant's claims, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

7. Appellant disagrees with the Examiner's conclusions set forth in paragraph 3 on page 5 that Evans "teaches a system as claimed, wherein said means for requesting said medical data includes means for indicating what part of said records is

desired (see figure 15A)". To the contrary there is no basis given in figure 15A for such unsupportable conclusion. Figure 15A discloses steps associated with locating the patient id (PID), 251, and locating the patient record, 254. Nowhere within figure 15A (or for that matter anywhere else within Evans) is the problem addressed of locating within the patient record a specific "part of said records," as addressed by claims 6 and 47, or "identifying the reason that said records are desired," as addressed by claims 7 and 48 of Appellant's system. However, even if such references in figure 15A of Evans were considered to teach or suggest locating a part of a record and/or identifying the reason such records were desired by the requesting party, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

8. In the fourth paragraph on page 5, it is similarly erroneous to suggest that there is any basis, either expressly stated or implied in Evans, to assert that tracking "referrals by entering the identity of persons referring [the] patient to their care should be read as "means for identifying records fulfilling such request further include data symbolic of medical symptoms". The Examiner has not shown (nor could he) that Evans expressly states or suggests his use of these terms should incorporate this additional meaning, nor that the proposed meaning is inherent in

the ordinary and customary definition of the terms employed. Elements 252 and 254 of figure 15A, which are expressly cited by the Examiner, are the patient identifier and the patient record, neither of which are data symbolic of medical systems. However, even if such references in figure 15A of Evans were considered to teach or suggest data symbolic of patient symptoms, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

9. With regard to the fifth paragraph on page 5, the system returning the provider to the patient chart window does not propose or suggest "identifying records fulfilling data symbolic of the attributes, levels or findings indicated within said diagnostic tests." Clearly, figure 7 and the corresponding portion of the Evans' specification address collect and view diagnostic test data. However, nowhere within Evans is the problem addressed of searching for specific parts of the patient record, much less specific attributes within specific parts of the patient record, as addressed by claims 10, 11, 51 and 52 of Appellant's system. However, even if such references in figure 7 of Evans were considered to teach or suggest locating a part of a patient's record based on the attributes, levels or findings within earlier diagnostic tests, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

10. With regard to the last paragraph of page 5 of the Examiner's Answer, Evans does not propose or suggest that consultation "regarding courses of action to obtain a diagnosis" should be read as suggested by the Examiner, as "include data symbolic of modes of treatment or medical services rendered." The Examiner does not explain (or could he) why the terms employed by Evans should be interpreted in a manner that is different than the ordinary and customary meaning, and he certainly cannot cite such teachings in the Evans reference itself. As noted above, nowhere within Evans is the problem addressed of searching for specific parts of the patient record, much less searching based on modes of treatment or medical services rendered, as addressed by claims 12, 13, 53 and 54 of Appellant's system. However, even if Evans' reference to consultation regarding courses of action to obtain a diagnosis were considered to teach or suggest locating a part of a patient's record based on the modes of treatment or medical services that were earlier rendered to that patient, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

11. With regard to the first full paragraph, page 6, Appellant avers that Claims 14-15 and 55-56 (being subordinate claims) patentably distinguish over Evans for reasons given with respect to Claims 1 and 8 (for Claims 14-15) and Claims 42 and 49

(for Claims 55 and 56). Moreover, Evans does not disclose or suggest that annotation of patient data by a health care provider should be read, as suggested by the Examiner, as "identifying records . . . including data symbolic of attending physician identity." The Examiner does not explain (nor could he) why the terms employed by Evans should be interpreted in a manner that is different than the ordinary and customary meaning, and he certainly cannot cite such teachings in the Evans reference itself. As noted above, nowhere within Evans is the problem addressed of searching for specific parts of the patient record, much less searching based on attending physician identity or the date of care, as addressed by claims 14, 15, 55 and 56 of Appellant's application. However, even if Evans' reference to annotation of records by a physician were considered to teach or suggest locating a part of a patient's record based on the attending physician or the date on which such medical services were earlier rendered to that patient, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

12. With regard to the second full paragraph on Page 6 of the Examiner's Answer, the Examiner's Answer fails to state the basis for his conclusion that the description at Column 2, lines 21-31, of the Evans reference indicates a "standing order" that will automatically initiate an attempt to retrieve certain pre-

determined types of medical data. Although the referenced passage states that the Evans system automates and simplifies existing methods of patient chart creation, maintenance and retrieval, it accomplishes these benefits in the specific manner taught by Evans. That reference cannot, merely by the statement of this broad objective, cover every other method of automating and simplifying the retrieval of patient data irrespective of whether it is expressly envisioned or taught in Evans. The fact is that Evans does not teach or suggest the creation of a "standing order" for retrieving pre-determined types of data in specified circumstances, as taught by Appellant. But even if it did, Claims 16, 30 and 57 (being dependent claims), distinguish for reasons given with respect to the claims from which they depend.

13. With regard to Claims 17, 58 and 63, discussed in the fourth full paragraph on page 6, the referenced section of Evans merely says "capture data in a patient record at a point of care, wherein the patient record includes a patient identifier and at least one data structure including the patient identifier and the data". It is a non-sequitur to contend that "capturing data in a patient record including a patient identifier" and the data itself either teaches or suggests the "names of each of the parties who's permission must be obtained prior to the release of the such (sic) medical data" inasmuch as, by Evans' own teaching,

such patient record only identifies the patient and the data itself. But even if it did, Claims 17, 58 and 63 (being dependent claims), distinguish for reasons given with respect to the claims from which they depend.

14. With regard to Claims 18-19, 59-61 and 78 discussed in the fifth full paragraph on page 6, the Examiner states that "Evans teaches a system as claimed, wherein said conditions required for accessing said medical data further includes (sic) an indication of the charge that will be assessed by the holder of such medical data for the part, or in the form, specified by the requesting party (citing Evans, Cols. 6,7, lines 54-67 and 1-5). However Appellant finds that the cited passage in Evans merely deals with the steps involved in accessing and filling out a form to enter an identification of the patient's problem. The reference says absolutely nothing about what the charges would be for permitting access to such record(s), nor does it (or any other portion of the Evans patent) even contemplate that payment for release of such record(s) might be proposed by the record holder. Accordingly, the Examiner's proposed reliance upon this reference is clearly erroneous.

15 a. With regard to Claims 20, 34 and 75 discussed beginning in the last paragraph on page 6, Appellant finds that the cited passage relates to a tiered password system rather than a "firewall limiting access to searching." The ordinary and

customary meaning of these terms are distinct and nowhere does Evans either suggest or imply that his use of the term "tiered password system" should include all of the attributes normally associated with a "firewall" by those skilled in the art and nowhere within Evans is there any teaching whatsoever of searching for portions of records as contemplated by Appellant's invention. However, even if such reference were considered to teach or suggest the firewall defined by Appellant's claims, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

15 b. With respect to Claim 22, Appellant submits there is no relevance to the Examiner's observations inasmuch as Claim 22 (in addition to the limitations of Claim 1 to which it is dependent) includes "means for a patient to grant permission for the release of his/her medical data." The granting of permission by a patient to the release of data is not related to a password system or firewall.

16. In the first full paragraph of page 7 discussing Claims 21, 31, 62 and 72, the cited portion of the Evans specification merely describes the location and description of patient data with a patient identifier along with grouping of data for rapid retrieval. Appellant is unable to find any teaching or suggestion of producing an indicia of the degree to which data

listed in such data index match specified criteria. This type of teaching pertains to searching for records. Since, as noted above, the Evans patent does not even provide for such searches (nowhere is the word or concept of "search" even used within Evans), it is illogical to assume that the degree to which search results match specified criteria would be addressed in Evans. However, even if such reference were considered to teach the additional features defined by Appellant's claims, the claims (being dependent) are patentably distinguishable on grounds set forth with respect to the claims from which they depend.

17 a. With regard to the second full paragraph on page 7 discussing Claims 23 and 67, the Examiner states that Evans teaches a system as claimed, wherein said at least one data base includes a billing means for access to said medical data. This is erroneous. As noted above, Evans does not even contemplate assessing a charge for access to patient data, much less describe any of the mechanics that would be involved in billing and collecting payments associated therewith. Additionally, with respect to Claim 23, Appellant deems it evident that it distinguishes patentably on the grounds cited for Claim 22.

17 b. With respect to Claim 67, Appellant submits there is no relevance to the Examiner's observations, inasmuch as Claim 67 (in addition to the limitations of Claim 42 to which it is dependent) includes "a step of identifying a party requesting

access to said medical data." The identification of a party requesting access is not related to a billing means.

18. As to the third full paragraph of page 7, with respect to Claims 24-25, 64 and 66, Appellant has searched the cited passage (as well as the rest of Evans) in vain for any reference to "the preferred means for contacting such party to request access to and release of the said patient's medical data". The cited passage merely states: "obtaining a patient identifier, locating a patient record corresponding to the patient identifier in the patient data repository, and determining the location of the patient data within the patient record." There is no teaching or suggestion of any means for contacting the patient to request permission to release data, let alone a preferred means. Similarly, there is no teaching or suggestion of any means for the patient to grant such permission to release the requested medical data.

19. With respect to Claims 26, 43 and 45-46, the last paragraph on page 7 states that "Evans teaches a system as claimed, further includes (sic) means for identifying the party requesting access to such medical data (see figures 17A and 17B, Col. 10, lines 42)". The cited passage reads: "As determined at 282, if the registry includes an interface for the external source . . ."; and the related item in Figures 17A and 17B are "registry include interface for external source?" The foregoing

responses are to step 280, described at Col. 10, Lines 38-41, "The data manager 202 issues a request 280 for patient data from an external source. At 282, the interface manager 270 determines if the registry includes an interface for the external source" However, in Evans the data manager 202, as defined at Column 8, Lines 20-22, is not a "party" but is merely one of the components of the patient data repository 102. As such it is either hardware or (more likely) software that is specially programmed in order to emulate hardware and perform these functions. Accordingly, Evans can hardly be said to be "identifying the party" (i.e., the patient, a specific provider or some other person) "requesting access to such medical data," let alone authenticating that person's identity.

20. As to the first paragraph on page 8 discussing Claims 27-29, 68-69 and 73, lines 53-60, Column 2 of Evans read: "electronically annotate patient data. Thus, a healthcare provider can acknowledge reviewing patient data, provide instructions, such as prescriptions for medication to administer to a patient, and approve recommendations for treatment by other providers, all by electronically annotating a patient's record. In addition, authorized healthcare providers can access a record while other providers use the same record for real-time collaboration." The Examiner states that "Evans teaches a method as claimed, further includes (sic) means for producing an indicia

of the required approvals for the release of such medical data that have not been secured, or that have been specifically declined (see Col 2, lines 53-60)." Nowhere in the quoted passage (or anywhere else in Evans or any other prior art of which Appellant is presently aware) is there any teaching or suggestion of "means for producing an indicia of the required approvals for the release of such medical data that have not been secured". Obviously, such does not exist from any kind of fair reading of the quoted text without first having reference to Appellant's specification and impermissibly using it as a guide.

21. With respect to Claims 32-33 and 40 discussed in the second paragraph on page 8, Appellant would respectfully state that there is a substantial and patentable difference between a patient's billing information (i.e., the information used by providers when billing services, as such as addressed in Evans) and "means for billing a party requesting medical records" for charges associated with furnishing the medical data (as contrasted with charges for medical treatment). In addition, Claims 32-33 and 40 are deemed to patentably distinguish over the references for the reasons given with respect to Claim 1, to which each is dependent.

22. In the third paragraph on page 8, as to Claims 35-36 and 71, the Examiner states that "Evans teaches a system as claimed, further includes (sic) means for producing an indicia

that the requested medical data have been received in an online memory cache means and are being held there for download by the requesting party." (citing Cols. 9 and 10, lines 61-67 and 1-17.) However, as indicated by figure 12 and described at Col. 9, Lines 15-16, the Evans' cache is not an on-line cache but rather is a part of the internal system. Thus it is both structurally as well as functionally different from the on-line cache defined by Appellant's claims. There is no mention or suggestion anywhere within the Evans reference of using the cache to protect data, and certainly no teaching that the cache will prevent a party from gaining access to "hack" into the patient data repository. Evans' stated intention is that such cache only facilitates quick access to such data, whereas for Appellant's claimed subject matter, the reason for using the cache relates to data security and data protection. Moreover, Claims 35-36 and 71 patentably distinguish over Evans on the grounds set forth for the independent claims to which they are dependent.

23. Referring to the fourth paragraph on page 8 discussing Claims 37, 39, 47 and 80-81, lines 25-30, Col. 3 of Evans read as follows: "method of retrieving patient data in an electronic medical records system having a patient data repository, comprising the steps of obtaining a patient identifier, locating a patient record corresponding to the patient identifier in the patient data repository, and determining the location of the

patient data within the patient record." Appellant submits that this cannot possibly be construed to teach or suggest a "step of creating a security log and retaining an audit trail with regard to all of the communications between the parties" as required by the claims. Thus, the Examiner's argument mis-characterizes Evans' disclosure, and the conclusions drawn therefrom are inaccurate and erroneous.

24. As discussed in paragraph 5 on page 8, with respect to Claims 38, 74 and 79, lines 53-64, Col. 1 of Evans read, "Physicians often use paper based forms and charts to document their observations and diagnosis. Laboratories also produce patient data in numerous forms, from x-ray and magnetic resonance images to blood test concentrations and electrocardiograph data. Clinics and hospitals may use a combination of paper based charts and electronic data for patient records. The same patient data may exist in remote patient files located at clinics, hospitals, laboratories and physicians' offices. Similarly, patient files at one healthcare provider typically have different information than patient files at another healthcare provider. When in use, patient files are generally not available to other healthcare providers." The Examiner has attributed to the foregoing quoted passage Appellant's teaching of "informing the requesting party when medical data is in a non-digital form and the mode of such delivery." However, since the quoted passage is presented in the

context of identifying a number of the problems of the then current art (rather than in any way identifying the mode in which Evans intends to transmit information), it is evident that unwarranted and unsupported assumptions underlie the Examiner's conclusions and that the Examiner is impermissibly using Appellant's specification as a guide to reach his conclusions, not any prior art. Nonetheless, even if Evans contained the required teaching (which it does not), these claims patentably distinguish on the grounds set forth with respect to the claims from which they depend.

25. Figure 22 has been asserted by the Examiner in the sixth paragraph on page 8 as disclosing "means for allowing parties to advertise in the public portions of said system". However, Figure 22 is said by Evans to show "an example of a medication interaction window of the medication manager of Figure 21"; Figure 21 is said to show "an example of a graphical user interface for the medication manager of the reference database of Figure 18"; and Figure 18 is said to be "a block diagram illustrating the structure of the reference of database of Figure 1." Nowhere in any of these references is Appellant able to find any teaching or suggestion of a "means for allowing parties to advertise in the public portions of said system" as averred by the Examiner and required by Claim 41. However even if Evans contained the alleged teaching (which it does not), Claim 41

patentably distinguishes on the grounds set forth with respect to Claim 1 to which it is dependent.

26. With respect to Claims 65 and 70 (discussed in the last paragraph on page 8), the Examiner states that "Evan (sic) teaches a method as claimed, wherein said step of providing for a party to grant permission includes data symbolic of the identity of such party and data symbolic of the preferred means for contacting such party to request access to and to the release of said patient's medical data." In support of thereof, the Examiner cites Col 2, lines 53-60 of Evans which read: "electronically annotate patient data. Thus, a healthcare provider can acknowledge reviewing patient data, provide instructions, such as prescriptions for medication to administer to a patient, and approve recommendations for treatment by other providers, all by electronically annotating a patient's record. In addition, authorized healthcare providers can access a record while other providers use the same" Appellant points out that neither in the cited passage nor anywhere else in the Evans reference, is there any teaching or suggestion of "data symbolic of the preferred means for contacting such party to request access to and to the release of said patient's medical data" (as asserted by the Examiner). Clearly, neither Evans's system nor any other system of which Appellant is presently aware at the time of filing his application, contemplated providing the

patient with the opportunity for giving informed consent. Accordingly, it is evident that the Examiner's assertion has been made in error. Moreover, Claims 65 and 70 patentably distinguish over Evans on the grounds set forth for the independent claims to which they are dependent.

27 a. With respect to Claims 76 and 77 discussed in the first paragraph on page 9, it is again noted that the cache defined in Claims 76 and 77 is an on-line cache and, as mentioned above, is distinguishable from the internal cache of Evans. Inasmuch as the cache in Evans is shown as being an integral component of the patient data repository 102 (see Figure 12) and used principally for quick access to portions of the data archive 208 which is also a component thereof, there would be no reason for the system envisioned in Evans to send a notice that requested medical data had been received and was being held for download in said cache by a requesting party, as addressed by Claim 76, and/or for establishing a firewall specifically for controlling access to said cache by said requesting party, as addressed by Claim 77. In point of fact, the Evans patent does not disclose or suggest either of these claimed attributes. However, even if it did, Claims 76 and 77 are deemed to distinguish patentably over Evans for the reasons given with respect to Claim 42, the claim to which Claims 76 and 77 are ultimately dependent.

27 b. In addition to the foregoing, Appellant refers to the sections in his original and supplemental briefs that show patentable distinctions of his claims over the Evans reference. These sections are set forth at pages 14 et seq of the original brief and at pages 15 et seq of the supplemental brief.

Section II (Beginning on Page 9 of the Examiner's Answer)

28 a. In referring to the rejection of Claims 3 and 44, the Examiner reaches the unsupported conclusion that it would have been obvious to a person of ordinary skill in the art to modify the teachings of Evans and Anderson. These arguments are unsupported and incorrect for the reasons set forth in Appellant's Supplemental Brief beginning at page 24. In addition, as mentioned above, the fact that modifying Evans to include overt denial of access except under the conditions set forth in Appellant's application and claims would appear to be an argument in support of (rather than in derogation of) patentability, for if Appellant's modification provides an improvement (where there has clearly and demonstrably been a long-felt need in the art, as mentioned below and as described in detail in Appendix C to the Supplemental Brief), this is a well-recognized factor supporting non-obviousness. As indicated above, in addition to finding no express identification of the motivation to combine included within either Evans or Anderson, Appellant finds no reference in the Examiner's Answer to

Appellant's arguments relating to the aforementioned long-felt need in the art which unquestionably supports patentability.

28 b. As stated in Ex Parte Ryan 38 USPQ 550, and subsequently in other cases: "However, as has frequently been said, the facts of the history of the art development is a better guide as to what is, or is not, obvious than mere speculation."

28 c. The Examiner has chosen to completely ignore the evidence made of record by Appellant that is set forth in Appendix C of both the original and supplemental Appeal Briefs and discussed in depth in both briefs.

28 d. Beginning on page 23 of the original brief and page 44 of the Supplementary Brief, Appellant made reference to the three documents listed in Appendix C which were made of record during the examination of the instant application on appeal. These references show the long-felt need for Appellant's invention by those skilled in the art to which this invention relates. These documents show the need for and failure to attain the privacy desired for patient medical records, something solved by Appellant's instant invention. This is the most probative and cogent evidence of record and clearly establishes that even if one assumes *arguendo*, that all the implicit showings as to Evans made by the Examiner are correct, it would still not render the instant claims on appeal obvious to one skilled in this art.

28 e. Appellant can only surmise that the Examiner has

failed to comment on these references because they contravene what he has unsupportedly set forth as knowledge of those skilled in this art.

THE EXAMINER'S RESPONSE TO APPELLANT'S ARGUMENTS

(Page 10 of Examiner's Answer)

1 a. The Examiner states that Appellant's assertion "is incorrect because Evans indicates the point of care system issues a request for patient data, the patient locator receives the request from the point of care system and attempt (sic) to find the patient ID for the record having the requested patient data, as determined if no patient ID is found the patient locator reports an error, at this point the patient data repository may recover from the error by either restarting the process or by ending the process ("ending process" is readable as denied access)." (Underscoring added).

1 b. The foregoing, however, is directly contrary to the Examiner's admission on page 4, beginning on line 5 "But Evans does not explicitly indicate data processing means responsive to a request for patient medical data for comparing said request with said conditions required for access to said data and, when said request fails to comply with said conditions for denying access to said data." (Underscoring added). Reconciling the Examiner's observations appears to require (i) an interpretation

of the patient identifier as a condition; and (ii) equating "ending process" with "overt denial of access", neither one of which appears to be consistent with the context in which the terms appear.

1 c. Concerning the foregoing contention that "ending process" is effectively equivalent to an "overt denial of access", Applicant has previously written: "To accept Examiner's argument would be equivalent to believing that the mere fact that when a caller incorrectly dials a person's telephone number the phone system is incapable of completing the call, negates the novelty of a system that is capable of blocking all incoming calls unless specific pre-conditions are first met." (See Request for Reinstatement, at pages 20-22) The Examiner has not made any effort to address this objection, or explain the basis for continuing to contend that the two terms should be read as being equivalent.

1 d. Concerning the foregoing contention that the PID is equivalent to a condition as covered by Appellant's claims (rather than merely an "identifier" as the name Evans designated for it expressly states), Appellant has noted that failure to state a correct PID results in the failure of the system to know what to do next, and thus the indication of an error. Thus, with respect to figure 15a, Evans discloses "As determined at 252, if no PID is found, the patient locator 200 reports an error 253.

At this point, the patient data repository 102 (Fig. 1), may recover from the error 253 by either restarting the process or by ending the process." (Col. 9, Lines 44-48). As a consequence, a correct PID in the Evans system would result in immediate access to the data whereas a correct PID in Appellant's system without fulfilling the conditions expressly established for access to such data, would result in an over denial of access.

2. In response to the Examiner's comments in the second full paragraph on page 12, it is understood that limitations from the specification are not read into claims. However, the meanings properly attributable to claims are interpreted in light of the specification and should not be taken out of context nor given tortured meanings. As indicated with respect to numerous claims in Part I, the Examiner has repeatedly ignored ordinary and customary meanings of terms, and instead imposed his own tortured reading of phrases within the Evans specification (many of which interpretations are not even consistent with the balance of the Evans disclosure). Appellant avers that there is no basis for one skilled in the art - reading the two documents and considering the claims in context and without benefit of hindsight - to conclude that Evans teaches a system as claimed in Appellant's application and each and every one of 81 claims. Despite his purported agreement that claims must be interpreted "consistent with the specification," the Examiner has not done so

for the reasons pointed out above and in Appellant's briefs.

3 a. In the first full paragraph of Page 11, the statement is made that "Implicitly Evans indicates as determined if no patient ID is found the patient locator reports an error at this point the patient data repository may recover from the error by either restarting the process or by ending the process ("ending process" is readable as denied access)." In this connection, please see the comments above with respect to "ending process". As noted above, Appellant contends that Evans did not intend and persons of ordinary skill in the art would not understand a patient identifier (PID) to be a "condition." However, even if one assumes that "entering a current and accurate patient identifier" is a condition, effectively as the Examiner contends, there can be no mistake that the parent claims (both Claims 1 and 42) include the plural form of condition, i.e., "conditions". Accordingly, even if one accepts the Examiner's contention that "ending process" because of the failure of the entered data to match a patient ID (i.e., a single condition), there is no teaching of a plurality (i.e., "conditions") being required to access such data. This having been said, it is obvious from a fair reading of the Evans' and Appellant's disclosures that Appellant's conditions are markedly different from the alleged condition of Evans. In this connection, please see numerous references in Appellant's specification describing such

conditions including references on pages 6, 8, 9, 17, 23, 24, 25, 26, 27, 28, 37. An example of such references is that on page 23, line 13 reading "... and an order form indicating all of the approvals required before the holder will release it."

(Underscoring added).

3 b. It is noted again that the Examiner stated "Implicitly Evans indicates" In this connection, Applicant refers to the enclosed dictionary definition of "implicit" as set forth in The New College Edition of The American Heritage Dictionary of the English Language (copies included herewith) in which "Implicit" is defined as: "Implied or understood although not directly expressed. Inherent or contained in the nature of something although not directly expressed." In short, it is synonymous with "inherent". In this connection, it is requested that the Honorable Board take Judicial Notice of the foregoing definition.

3.c. As the courts have long held, inherency can only be established if the extrinsic evidence makes clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill. As stated in In re Robertson 49 USPQ2d 1949 (Fed Circuit 1999):

3.d. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient."

3 e. The Examiner repeatedly acknowledges that Evans does not explicitly disclose any data processing means responsive to a request for patient medical data for comparing said request with said conditions required for access to said data, when said request fails to comply with said conditions, for denying access to said data as claimed by Appellant. Reference to Col 9, lines 39 to 48 and Figs 15A and 12 of the Evans patent shows that the only action the patient locator 200 can take is to report an error if the [alleged] one condition is not met; namely, the patient's unique identifier (PID) (Line 45). It cannot deny access to the patient data. At this point, a separate processing means 102 may recover from that error by either restarting the process (not a denial of access to the data) or ending the process (again, not a denial of access to the data). Thus, neither means 200 nor means 102 can alone or in combination, compare the request for patient medical data with the conditions (as set forth on the above-identified pages of Appellant's specification) required for access thereto and deny access to said data if the request fails to comply with the conditions required for access.

3 f. Thus, what Appellant has claimed is not inherent in Evans and the Examiner has not set forth that "it would be so

recognized by persons of ordinary skill in this art." All there is of record is the Examiner's unsupported statement to that effect, which Appellant avers is not a proper basis for rejection.

3 g. In the last paragraph on Page 11, the Examiner again admits that Evans does not explicitly indicate the subject matter of Claims 1 and 42, stating that "ALTHOUGH EVANS DOES NOT EXPLICITLY INDICATE THE STEPS OF CLAIMS 1 AND 42, EVANS CLEARLY TEACHES THE CLAIMED SYSTEM". However, since he admits no explicit teaching, there must be a sustainable basis for his conclusion that Evans teaches the claimed system. Appellant has been unable to find a supportable basis for the contention that Evans clearly teaches the claimed system. In this connection, Appellant respectfully calls attention again to the recent case of In re Robertson cited above which reads: "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill'" (underscoring added). Reference is also made to Scaltech Inc. v Retec/Tetra, L.L.C., (51 USPQ2d 1055, Fed Circuit 1999): "The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency." Accordingly, the Examiner's unwarranted conclusions are deemed unsupported and should be overturned.

4. In the first full paragraph on page 12, the Examiner describes the optional inclusion of a cache 206, together with the coordination of transfer of patient data to and from a data archive 208. However, the Examiner provides no support for his conclusion that Evans' system would provide protection for the data in the memory cache in the described instance. The functions of the data manager 202 cited by the Examiner do not provide any greater protections for the data within the cache than they do for the remainder of the system. Moreover, and as described in detail in Section I, certainly the Evans system does not provide the numerous protections afforded by Appellant's system (nor was it intended to).

5 a. In the last paragraph on page 12, the Examiner admits that "Each applied reference does not expressly suggest combination with the other respective references". However, the Examiner asserts that motivation for combining the references existed in the prior art, although he has not identified such. In this connection, he did say that the "modification would allow the teachings of Evans to improve the accuracy and the reliability of the standing order database search system (bottom of page 4 of Examiners Answer). However, as mentioned above, in view of the long-felt need, such speaks in support of (rather in derogation of) non-combinability and of the patentability of Appellant's claimed inventions.

5 b. In this connection, Appellant again observes that the Examiner's Answer did not address the important issue of long-felt need as set forth on pages 44 et seq of his Supplemental Appeal Brief, as more fully discussed above. Nor was Appellant able to find any argument as to the inapplicability of the quotation earlier on page 44 of the statement that "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference."

5 c. Additionally referring to the last paragraph on page 12 of the Examiner's Answer, the italicized passage is noted which states "*or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.*" However, Appellant observes no basis in the Examiner's Answer to support his unsupported conclusion that such knowledge was available to one skilled in the art. Just saying so without any support does not make it so. The long-felt need (coupled with the advantages derived therefrom), clearly overcomes the Examiner's assumption of obviousness.

6. In the first full paragraph on page 13, in discussing impermissible hindsight, the Examiner states "In this case, Anderson teaches researchers want access to records which cannot effectively be made anonymous then every effort must be made to

inform the patient and gain his consent." This is merely an acknowledgment of the problem that Appellant's invention solves and does not disclose or suggest any aspect of Appellant's claimed invention which solves this problem. Moreover, in addition to being awkward in syntax and difficult to understand, Appellant observes no evidence to support a contention that there is no impermissible hindsight in an attempted combination with Evans.

7. With respect to the second paragraph on page 13, Appellant was only setting forth a hypothetical analogy to assist the Examiner in understanding the conditions.

8. With respect to the last paragraph on page 13 and its continuation at the top of page 14, Appellant understands that the Examiner is required to show facts (extrinsic evidence) supporting his conclusion that the relevant knowledge was within the level of those of ordinary skill in the art. Just a supposition based upon his belief (without specific substantiation) is unsupportable. Please see In re Robertson (above) in which the Court stated at page 1951, "In finding anticipation by inherency, the Board ignored the foregoing critical principles. The Board made no attempt to show that the fastening mechanisms of Wilson that were used to attach the diaper to the wearer also 'necessarily' disclosed the third separate fastening mechanism of claim 76 used to close the diaper

for disposal, or that an artisan of ordinary skill would so recognize. It cited no extrinsic evidence so indicating."

(Underscoring added). Please also see the case of In re Bozek discussed below.

9. The penultimate paragraph on page 14 states that "Appellant appears to misinterpret the guidance given under MPEP 2142" and "In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures" (Citing In re Bozek, 163 USPQ 545, (CCPA, 1969).

(Underscoring added). This is patently incorrect. What the Court said was that a reference disclosure must be evaluated for all that it fairly suggests and not only what is indicated as preferred. Appellant would also quote from the Bozek decision: "Having established that this knowledge was in the art, the examiner could then properly rely as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference'."

(Underscoring added). Therefore, one would conclude that before relying on such knowledge one must ESTABLISH that the knowledge exists in the art. That this has not been done in the instant prosecution is starkly evident from the foregoing and from the remainder of the record.

In conclusion, it will be seen that the rejections advanced

by the Examiner are unsupportable; and it is respectfully requested that they be overturned and that the claims be allowed.

Respectfully,



Andrew M. Hassell
Registration No. 18182
Attorney for Appellant
12568 Burninglog Lane
Dallas, Texas 75243
Tel: (972) 234-6540
Fax: (972) 234-6540

CERTIFICATE OF MAILING

I hereby certify that the above-noted paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D. C. 20231, on March 26, 2003.



Andrew M. Hassell



SUPPLEMENT TO APPENDIX B*
AUTHORITIES ON WHICH RELIED

Appellant adds references to the following authorities:

19. Ex Parte Ryan 38 USPQ 550 (Patent Office Board of Appeals, 1938) "However, as has frequently been said, the facts of the history of the art development is a better guide as to what is, or is not, obvious than mere speculation."

20. In re Robertson 49 USPQ2d 1949 (Fed Circuit 1999) "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

21. Scaltech Inc. v Retec/Tetra, L.L.C. 51 USPQ2d 1055 (Fed Circuit 1999) "The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency."

*Of Appellant's Supplemental Appeal Brief

RECEIVED
APR 02 2003
Technology Center 2100

NEW COLLEGE EDITION



THE AMERICAN HERITAGE
DICTIONARY
OF THE ENGLISH LANGUAGE

BEST AVAILABLE COPY

BEST AVAILABLE COPY

Words that are believed to be registered trademarks have been checked with authoritative sources. No investigation has been made of common-law trademark rights in any word, because such investigation is impracticable. Words that are known to have current registrations are shown with an initial capital and are also identified as trademarks. The inclusion of any word in this Dictionary is not, however, an expression of the publishers' opinion as to whether or not it is subject to proprietary rights. Indeed, no definition in this Dictionary is to be regarded as affecting the validity of any trademark.

© 1969, 1970, 1971, 1973, 1975, 1976, 1978, 1979, 1980 by Houghton Mifflin Company
All correspondence and inquiries should be directed to
Reference Division, Houghton Mifflin Company
Two Park Street, Boston, Massachusetts 02107

All rights reserved under Bern and Pan-American Copyright Conventions

ISBN: 0-395-20360-0 (new college edition; thumb-indexed)
0-395-20359-7 (new college edition; plain edges)
0-395-24575-3 (high-school edition)
0-395-09066-0 (larger-format edition)

Library of Congress Catalog Card Number 76-86995

Manufactured in the United States of America

Computer-composed by Inforonics, Inc.
in Maynard, Massachusetts

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☒ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.